

Appl. No. 10/516,672

Amdt. dated September 15, 2009

Reply to Office Action of 04/15/2009

REMARKS

Reconsideration of the present application, as amended, is respectfully requested. As a result of the present amendment, claims 25-29, 31-32, 36-41, 43-46, and 51-54 are under prosecution.

AMENDMENTS TO THE CLAIMS

Claim 25 is amended to move the phrase, “at temperatures above 200°C” to follow the term, “hydroisomerizing” for greater clarity. This is submitted to be fully supported by the specification, which makes it clear that this temperature range applies to the “hydroisomerizing” step. Claim 31 is amended to recite a broader mass % range for the transition group 8 metal, and claim 44 is amended to recite a narrower mass % range for platinum, relative to claim 31. The amended transition group 8 metal range for claim 31 is supported by page 5, line 36, *et seq.*, of the specification. The amended platinum metal range for claim 44 is supported by page 7, lines 14-15, *et seq.*, of the specification.

At the Examiner’s suggestion, a “%” symbol is inserted for each numerical mass ratio. These amendments are supported by the specification, which makes it clear that the claimed mass ranges are given as percentages.

No new matter is added.

THE CLAIM OBJECTIONS ARE OBLIVIATED

At items 6-7 of the Office Action, the Examiner has objected to claim 44 as being in improper dependent form for reciting a mass range for platinum that is broader than what is recited by claim 31. The Examiner’s attention to this point is appreciated, and claims 31 and 44 are now amended so that claim 31 recites a composition of 0.1 to 2.0 % by mass % for a transition group 8 metal, and claim 44 now recites a composition of 0.2 to 2.0 % by mass % for platinum. Thus, it is submitted that these grounds of objection is obviated.

For all of these reasons, reconsideration and withdrawal of these grounds of objection is respectfully requested.

**THE CLAIMS ARE DEFINITE
UNDER 35 USC § 112, SECOND PARAGRAPH**

At items 8 and 9 of the Office Action, the Examiner has rejected claims 25 and 31 as allegedly indefinite for not reciting mass percentages of the recited proportions of materials. The Examiner's attention to this point is appreciated, and claims 25 and 31 are amended as suggested by the Examiner. Thus, it is submitted that these grounds of rejection are obviated.

For all of these reasons, reconsideration and withdrawal of these rejections is respectfully requested.

**THE REJECTIONS UNDER 35 USC § 102(e) AND
35 USC 103 OVER John et al. (U.S. 7,169,726) ARE OBLIVIATED**

At items 14-23 of the Office Action, claims 25-29, 31-32, 36-41, 43-46 and 51-54 are rejected under 35 USC § 102(e) as allegedly anticipated, or alternatively, under 35 USC § 103(a) as allegedly obvious over John, *et al.*, U.S. Patent No. 7,169,726 (the John patent).

Applicants respectfully disagree. At item 14 of the Office Action, the Examiner has invited the Applicants to perfect the claimed priority dates of the present patent application. Applicants enclose herewith, for the Examiner's consideration, the certified translations of the two foreign priority documents:

German Patent Application No. 102 56 431.0, filed on December 2, 2002 and

German Patent Application No. 102 37 651.4, filed on August 13, 2002.

Upon perfection of the above noted priority dates, it is submitted that the John patent is not available as a reference under 35 USC 102(e), since the John patent claims priority from foreign patent applications, and from a PCT application that was not published in the English language. Thus, it is submitted that the 35 USC 102(e) date for the John patent is its U.S. filing date of May 30, 2003 [see MPEP 706.02(f)(1)].

On an additional note, in a non-102(e) consideration, it should be appreciated that the John patent claims the same priority as does the instant patent application, and is therefore not from "before" the instant patent application.

For all of these reasons, reconsideration and withdrawal of these rejections is respectfully requested.

**THE CLAIMS ARE NOVEL AND NONOBVIOUS
OVER HOEK, AND HOEK IN VIEW OF EILERS AND/OR BERTAUX**

At item 27 of the Office Action, the Examiner has rejected claims 25-29, 31-46, and 51-53 as allegedly "unpatentable under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, claims 25-50 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Hoek (US 200410199040)." The Examiner further rejects claims 25-50 under yet another alternative theory, "under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoek, as evidenced by Eilers (EP 668342 A1) and/or Bertaux (EP 776959 A2)." The Examiner enumerates the rejections in detail at items 28-39 of the Office Action.

Applicants respectfully disagree. Anticipation requires the presence in a single prior art disclosure of each and every element of a claimed invention. *Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052 (Fed. Cir. 1994) or see the Manual of Patent Examining Procedure (MPEP) §2131. However, this is not enough to sustain a *prima facie* anticipation rejection. More is required. As explained by the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. [*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick & Co.*, 221 USPQ 481, 730 F.2d 1452, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983))].

See also, Akzo N.V. v. United States Int'l Trade Comm'n, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed.Cir.1986), cert. denied, 482 U.S. 909, 107 S.Ct. 2490, 96 L.Ed.2d 382 (1987) which explained that,

Under 35 U.S.C. Sec. 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed.Cir.1983), cert. denied, 469 U.S. 851, 105 S.Ct. 172, 83 L.Ed.2d 107 (1984). In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964).

Thus, in order to maintain a *prima facie* allegation that a claim is anticipated by a reference, it is clear that a single reference must describe the invention as claimed, and also enable the invention as claimed. A mere listing of parts or elements, not teaching the invention as actually claimed, is submitted to fail to anticipate, even if some of the elements of the reference might resemble or even be the same as the elements of the claimed invention.

Here, it appears that the Examiner has impermissibly used Applicants' specification as a road map for picking and choosing particular elements from Hoek and Eilers and/or Bertaux. The Examiner concedes, at item 28 of the Office Action, that Hoek fails to teach employing FT paraffins with a carbon chain length distribution from 20 to 105, and also concedes that Hoek fails to teach that the catalytic hydroisomerization occurs in the presence of a catalyst comprising beta zeolite and gamma aluminum oxide. The Examiner then relies on Eilers and/or Bertaux to remedy this clear deficiency. The product of claim 25 is prepared by a specific process. The process of claim 31 is a specific set of steps, as follows:

processing FT (Fischer-Tropsch) paraffins, as a starting material, having carbon atoms in the range from 20 to 105;
in the presence of a catalyst based on a β -zeolite;
wherein the process is conducted at a temperature above 200°C, and
at a pressure in a range of 2 to 20 MPa in the presence of hydrogen...

The catalyst employed by the process is defined by claim 31 as follows:

wherein the catalyst comprises 60 to 95% by mass of zeolite of the beta type, based on the combination of all components fired at 800°C, 5 to 39.8 by mass of gamma-aluminum oxide having a specific surface area of 150-350 m²/g, calculated as Al₂O₃ and based on the combination of all components fired at 800°C, and one or more metals of transition group 8 of the periodic table, in an amount of 0.1 to 2.0% by mass, based on the combination of all components fired at 800°C, the one or more transition group 8 metals being attached to the gamma-aluminum oxide.

It is submitted that Hoek fails to disclose the product of claim 25 or the process of claim 31, with each and every one of the elements of each respective claim, organized as indicated by each claim. This is confirmed by the enumeration, in the Office Action at items 29-39, of all of the disparate elements of Hoek, taken alone or in view of Eilers and/or Bertaux. It is also submitted that Hoek, taken with Eilers and/or Bertaux, fails to enable the specific invention as recited by claims 25 and/or 31. Thus, it is urged that the rejection under 35 USC § 102(e) be reconsidered and withdrawn.

Turning to the alleged rejection under 35 USC § 103(a). In order to make out a *prima facie* rejection of the claims as allegedly obvious, the facts must show that the elements of the rejected claim(s) are present or suggested, e.g., by one or more references. The claimed invention must be viewed as a whole. See generally MPEP §§ 2141 and 2142. Further, the obviousness rejection cannot be a legally impermissible form of "obvious to try."

For example, the Federal Circuit has explained, in the case of *In re Kubin*, 2008-1184, (Fed. Cir. 2009) quoting *In re O'Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988), as follows:

To differentiate between proper and improper applications of “obvious to try,” this court outlined two classes of situations where “obvious to try” is erroneously equated with obviousness under § 103. In the first class of cases, what would have been “obvious to try” would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. *Id.* In such circumstances, where [the Examiner] merely throws metaphorical darts at a board filled with combinatorial prior art possibilities, courts should not succumb to hindsight claims of obviousness. The inverse of this proposition is succinctly encapsulated by the Supreme Court’s statement in KSR that where a skilled artisan merely pursues “known options” from a “finite number of identified, predictable solutions,” obviousness under § 103 arises. 550 U.S. at 421.

Here, the Bertaux catalyst, that is stated by Hoek to be preferred, is described in Example 1 of Bertaux, at Col. 6, lines 31-34 as a, "fluoridized NiW/alumina catalyst (5.0 %wt Ni, 23.1 %wt W, 4.6 %wt F, all based on total weight of carrier)." It is submitted that there is no teaching that points to the advantages of using a catalyst according to claims 25 or 31.

It is submitted that this Bertaux catalyst is a completely different catalyst from that preferred by Hoek (citing Bertaux), and that this further negates a finding of both anticipation and obviousness. The mention by Hoek and/or Bertaux of a preferred catalyst as platinum or palladium (Hoek, paragraph 8, or Bertaux at Col. 4, lines 27-360), are also urged to be general statements, that fail to provide the specific catalytic composition required by claims 25 and 31, *et seq.*, according to the requirements of *In re Kubin*. *Id.*

Thus, it is respectfully urged that the alleged obviousness rejection fails to provide any teaching indicating which of the combinatorial prior art parameters or elements of claims 25 and 31 would have been critical to success in producing the inventive paraffin. Without such a teaching, identifying which of the many possible elements and parameters described by Hoek, taken in view of Eilers and/or Bertaux, it would have been, at best, obvious to try, without meeting the legal burden necessary to sustain a *prima facie* rejection under 35 USC § 103(a).

For all of these reasons, reconsideration and withdrawal of these rejections is respectfully requested.

THE CLAIMS ARE NONOBVIOUS IN VIEW OF WITTENBRINK

At items 40-52 of the Office Action, the Examiner has rejected claims 25-29, 31-32, 36-46, and 51-54 as allegedly obvious under 35 U.S.C. 103(a) over Wittenbrink (WO01/74969 A2) in view of either Hoek and Bertaux or Carati (U.S. Patent No. 5,981,419). The Examiner concedes that Wittenbrink fails to teach that “the hydroisomerization occurs in the presence of a catalyst comprising β-zeolite and aluminum oxide,” but then points to Wittenbrink at page 8 as defining a support as any zeolite or refractory oxide, and to Hoek and Bertaux (beta zeolite or alumina) or Carati for teaching a beta zeolite support.

Applicants respectfully disagree. The burden is on the Patent Office to initially provide facts supporting a *prima facie* rejection under 35 U.S.C. 103(a). As noted above, in order to make out a *prima facie* rejection, the facts must show that the elements of the rejected claim(s) are present or suggested, e.g., by one or more references. Wittenbrink teaches so many varied reagents and process parameters for conducting a general Fischer-Tropsch reaction, that it would have been impossible for the ordinary artisan to have picked from among the many choices, to arrive at the claimed invention. According to *In re Kubin*, *Id.*, the Federal Circuit has held that it is an impermissible “obvious to try” rejection to pick and choose from a myriad of unconnected elements and parameters, as are present in Wittenbrink, without some “indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful” in the references. For this reason, it is urged that the Patent Office has not met its legal burden to sustain a *prima facie* rejection.

For all of these reasons, reconsideration and withdrawal of these rejections is respectfully requested.

CONCLUSION

In the event there are further issues remaining in any respect the Examiner is respectfully requested to telephone attorney to reach agreement to expedite issuance of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Since the present claims set forth the present invention patentably and distinctly, and are not taught by the cited art either taken alone or in combination, this amendment is believed to place this case in condition for allowance and the Examiner is respectfully requested to reconsider the matter, enter this amendment, and to allow all of the claims in this case.

FEES

This Response is being filed with a Petition for a Two-Month Extension of Time, and the fee required therefor. No further fee is believed to be due. If, on the other hand, it is determined that further fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275. Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

Respectfully submitted

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